

REMARKS

Entry of the foregoing, and further and favorable reconsideration of the subject application are respectfully requested.

By the present Amendment, the specification has been amended to insert a Brief Description of the Drawings, and to insert SEQ ID numbers at pages 26 and 27, as requested by the Examiner. No new matter has been added.

1. Turning now to the Official Action, Applicants note that the Examiner has maintained the Restriction Requirement in this case. Applicants renew their traversal of the Restriction Requirement on the grounds set forth in their previous Response. Applicants further renew their request that at least the claims of Groups I and III be rejoined and examined on the merits.

2. Applicants gratefully note that the draftsman has approved the drawings as submitted.

3. As requested by the Examiner at page 2 of the Official Action, a Brief Description of the Drawings has been added to the specification. The text of the Brief Description is consistent with that entered in the parent of this case, Serial No. 09/176,320 (now U.S. Patent 6,172,281).

4. As requested by the Examiner at pp. 2-3 of the Official Action, pages 26 and 27 of the specification have been amended to indicate the appropriate sequence identifiers for the bt4 gene and bt15 gene.

Claim Rejections - 35 USC §112

5. Claims 22, 24, and 26 are rejected under 35 USC §112, second paragraph, as purportedly indefinite. This rejection, to the extent that it applies to the claims as amended, is respectfully traversed.

6. Claim 22 is rejected as dependent on a non-elected claim. By the present Amendment, claim 22 has been amended to include the limitations of claim 20, from which it formerly depended. This amendment is not believed to narrow the scope of claim 22, or the claims that depend from it.

Claim 24 is rejected as purportedly lacking antecedent basis for the limitation "the DNA of claim 22" on the basis that "claim 22 is drawn to an isolated DNA sequence." However, as there is only one DNA referred to in claim 22, Applicants respectfully maintain one of ordinary skill in the art would fully understand the metes and bounds of claim 24 as written. There is simply no possibility of confusion as to what DNA is being referred to by the limitation "the DNA of claim 22" as set forth in claim 24. Consequently, Applicants respectfully request that the Examiner reconsider, and withdraw this rejection as it applies to claim 24, and the claims that depend therefrom.

Claim Rejections - 35 USC §102

7. Claim 22 is rejected under 35 USC §102(b) as purportedly "anticipated by Brizzard et al. (1988, Nuc. Acids Res. 16:4168-4169)." This rejection is respectfully traversed.

8. In order to anticipate a claim under 35 U.S.C. §102(b), a reference must teach every element of the claim. *See* MPEP 2131 *et seq.* The Examiner asserts, at page 4 of the Official Action, that "Brizzard et al teach a nucleic acid encoding cryA4, which is Bt14 in the nomenclature of the instant application (see pg 28, paragraph 1 of the specification)." However, Applicants respectfully direct the Examiner's attention to the full text of the paragraph on p. 28 in which the *bt14* gene is described:

The third gene isolated was called "*bt14*". It has an open reading frame of 3621 bp which encodes a 137 kDa protoxin and a 66 kDa activated toxin fragment. A similar gene has been cloned from *B. thuringiensis* HS-2 (Brizzard and Whiteley, 1988). **The *Bt14* gene differs from the published nucleotide sequence by two nucleotide substitutions: a T instead of a C at position 126, and a C instead of a T at position 448** (the numbers of the positions are according to Brizzard and Whiteley, 1988). **In the first case, the Ile codon (ATT or ATC) is conserved whereas in the second case the Tyr codon (TAT) is converted to a His codon (CAC).**

Thus the present specification clearly indicates that the Bt14 of the present claims differs from that disclosed by Brizzard et al. in two nucleotides, leading to a difference in one amino acid for the full length protein and any insecticidal fragment thereof. Consequently, because Brizzard et al. do not disclose every limitation of the invention of claim 22, Brizzard et al. cannot anticipate claim 22 under 35 USC §102(b). Withdrawal of this rejection is therefore respectfully requested.

Double Patenting

9. At pp. 4-5 of the Official Action, the Examiner has rejected claims 22, 24, and 26 under the judicially-created doctrine of obviousness-type double patenting as purportedly obvious over claims 4 and 22 of U.S. Patent No. 6,172,281, and over claims 6 and 14-15 of U.S. Patent 5,866,784. Without conceding to the merits of these rejections, Applicants hereby express their willingness to consider filing the appropriate Terminal Disclaimers in this case over U.S. Patents 6,172,281 and 5,866,784 upon indication that the claims in this case are otherwise allowable.

Conclusion

From the foregoing, further and favorable action in the form of a Notice of Allowance is believed to be next in order, and such action is earnestly solicited.

Should the Examiner have any questions concerning the subject application, the Examiner is invited to contact the undersigned attorney at the number provided below.

Respectfully submitted,

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